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| 10/552,154 | 10/11/2005 | Hiromu Ueshima | 04995/240001 | 9213 |

22511 7590 12/10/2009
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| EXAMINER |
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BIAGINI, CHRISTOPHER D

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| ART UNIT | PAPER NUMBER |
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2442

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12/10/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/552,154 | UESHIMA ET AL. | |
| | Examiner | Art Unit | |
| | Christopher Biagini | 2442 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27, 29 and 42-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27, 29 and 42-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/8/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement submitted May 8, 2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The information disclosure statement submitted on October 11, 2005 was considered on October 29, 2007. A signed copy was returned to the applicant along with the Non-Final Action mailed November 13, 2007.

Response to Arguments

Applicant's arguments with respect to the objection to the specification have been fully considered and are persuasive. Accordingly, the objection is withdrawn.

The amendment to claim 27 is sufficient to overcome the objection thereto. Accordingly, the objection is withdrawn.

Applicant's arguments with respect to the rejections of claims 46-48 under 35 USC 101 have been fully considered and are persuasive in light of the amendments to those claims. Accordingly, the rejections are withdrawn.

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Applicant's arguments with respect to the rejections of claims 27, 29, and 42-48 under 35 USC 112, second paragraph have been fully considered but are not persuasive.

Applicant argues that the term "proprietary" is used to "define a specific configuration, which is 'not compatible with pre-existing commercial systems.'" Applicant goes on to quote most of paragraph [0174], and asserts that one the meaning of the term is clear. The Examiner respectfully disagrees, and submits that paragraph [0174] was specifically addressed in the rejection. Applicant has provided no responses to the issues raised in the rejection.

Applicant's arguments with respect to the rejections of claims 27, 29, and 42-48 under 35 USC 103(a) have been fully considered and are persuasive in light of the amendments. Accordingly, the rejections are withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27, 29, and 42-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on

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notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “proprietary” in the claims is apparently used by the claims to mean “not compatible with pre-existing commercial systems,” while the accepted meaning is “made and sold by one with the sole right to do so.” The term is indefinite because the specification does not clearly redefine the term. Furthermore, both meanings—“not compatible with pre-existing systems” and “made and sold by one with the sole right to do so”—raise serious questions as to the metes and bounds of the claims.

With regard to the first meaning and using paragraph [0174] of the instant specification as a guide, it is unclear to what extent an existing system must be modified before it becomes “not compatible with the standard package of the mass-market flash memory module” and therefore “proprietary.” For example, if various existing commercial systems have slightly different receptacles for receiving a flash memory “package,” must the claimed device fail to fit one or all of them before becoming “proprietary”? Must any particular authority certify the original as “standard”? What degree of commercial success must the “standard” achieve to become “mass-marketed”?

With regard to the second meaning, it is not clear if a system becomes proprietary only upon granting of patent, trademark, or other exclusive rights. Furthermore, it is unclear whether the system would cease to become proprietary if it were licensed to more than one manufacturer.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27, 29, and 42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US Pub. No. 2003/0041123) in view of Braitberg (US Pub. No. 2001/0006503), and further in view of Hoffman (US Patent No. 6,622,017).

Regarding claim 27, Sato shows a content delivery system comprising:

- a memory device (comprising an optical disc or semiconductor memory: see [0033] and [0157];
- a content server (server 20) connected to a network and providing a content delivery service on the network (see [0032]); and
- a writer (user terminal 30) having a facility for receiving content from said content server through the network and writing the content to the memory device (see [0037]),
- wherein said writer writes the content only once in a writable storage area of said memory device where data has not been written (inherent to the operation of a CD-R disc: see [0033]), only when said memory device is appropriate for said content delivery system (comprising only when the device is determined to be legitimate: see [0047]),

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- wherein said content serve is configured to count the number of contents that has been successfully written to the memory device (see [0055]-[0056]), and
- providing for copyright fees (see [0034])

Sato does not explicitly show:

- that the memory device is a memory cartridge having a proprietary interface for accessing data contained therein;
- a content using system which is distributed to a user of said content and provided with a first proprietary connector compatible with and connectable to said proprietary interface of said memory cartridge for reading content therefrom and using the content;
- that the writer writes content through the first proprietary connector;
- that the writer is implemented within said content using system; and
- counting successfully written contents upon receipt of a notification that the content is successfully written to the memory cartridge, where the counted number is used to calculate the copyright fees.

Braitberg shows:

- a memory cartridge (storage cartridge 112 containing a write-once recording device: see Fig. 1, [0052], and [0060]) having a proprietary interface for accessing data contained therein (note that Braitberg introduces an enveloping cartridge which was not present in existing media: see [0019]-[0021]);
- a content using system which is distributed to a user of content and provided with a first proprietary connector compatible with and connectable to said proprietary

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interface of said memory cartridge for reading content therefrom and using the content (comprising, for example, a portable music player which has a drive containing the necessary mechanisms for reading data from the memory cartridge: see [0077]-[0080] and [0107]-[0108]);

- a writer that writes content through the first proprietary connector and that is implemented in the content using system (comprising a drive containing the necessary mechanisms for writing data on the memory cartridge: see [0077]-[0080] and note that the drive is capable of both writing data as a writer unit and reading data (i.e., using content as a content using system)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Sato to use a proprietary cartridge, content using system connectable with the cartridge, and writer in the content using system as taught by Braitberg in order to allow users to write and play back content from a durable, compact recording medium that avoids both physical damage and accidental erasure (see Braitberg, [0023]-[0024] and [0110]).

Hoffman shows counting successfully written contents upon receipt of a notification that the content is successfully written, where the counted number is used to calculate fees paid to a content producer (see col. 11, lines 5-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Sato to pay content producers their fee (e.g., their copyright fee) based on a counted number of successfully written contents in order to avoid paying the content producers for content that is never downloaded.

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Claims 29 and 42-48 correspond to claim 27 and are rejected for the same reasons as given above.

Claims 49-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US Pub. No. 2003/0041123) in view of Braitberg (US Pub. No. 2001/0006503), and further in view of Hoffman (US Patent No. 6,622,017) and “HP JFS 3.3 and HP OnLineJFS 3.3 VERITAS File System 3.3 System Administrator’s Guide” (hereinafter “the HP File System Administrator’s Guide”).

The combination shows the limitations of claims 27, 29, and 42-48 as applied above, and further shows:

- wherein said writable storage area comprises a plurality of blank areas (comprising the blank space on the disk: see Sato, [0015]), and
- wherein the writer consumes the writable storage area in accordance with a value of the content when the writer writes the content in the writable storage area (comprising consuming more storage space for less-compressed, more-expensive music: see Sato, [0059]).

The combination does not explicitly show that the writer consumes the writable storage area in units of blank areas.

The HP File System Administrator’s Guide shows consuming storage area in units of blank areas (comprising blocks: see p. 93). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system of Sato to consume storage in

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units of blocks in order to provide an abstraction of data storage that the software can use to read and write data.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Biagini whose telephone number is (571) 272-9743. The examiner can normally be reached on weekdays from 8:30 AM to 5:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Shawki S Ismail/

Primary Examiner, Art Unit 2455